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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/589,266      | 06/07/2000  | Barry Dworkin        | Dworkin.P001        | 8568             |

7590 09/09/2004

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EXAMINER

CHAMPAGNE, DONALD

| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 09/09/2004

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SEP 09 2004  
GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/589,266  
Filing Date: June 07, 2000  
Appellant(s): DWORKIN, BARRY

Aaron T. Borrowman, Esq.  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 June 2004.

cx. 1/3

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 4-13 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(9) Prior Art of Record**

|                  |                  |        |
|------------------|------------------|--------|
| US 20030050961A1 | Rodriguez et al. | 3-2003 |
| US 20030061566A1 | Rubstein et al.  | 3-2003 |
| US005922427A     | King             | 7-1999 |

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 26 November 2003.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 4-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is directed to nonfunctional descriptive matter. See MPEP 2106.IV.B.1(b), first paragraph.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-13 are rejected under 35 U.S.C. 103(a) as being obvious over Rodriguez et al. in view of King and Rubstein et al.

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5. Rodriguez et al. teaches (independent claims 4, 7 and 9) a multipurpose card and method for encouraging retention of business or greeting cards and simultaneously increasing visits to participating websites, the multipurpose card comprising: a business card, which, by definition, has business identifying indicia thereon (Webster's Collegiate Dictionary); and binary data printed thereon to initiate a link to an Internet site (para. [0006]), which reads on a web site address printed on the business card. Rodriguez et al. also teaches business/vendor promotions at the web site identified on the card (para. [0019]), so the Internet-linking binary data printed on the card reads on discount indicia printed on the card. Rodriguez et al. also teaches *calling cards* (para. 0022]), which reads on greeting cards.
6. Rodriguez et al. does not teach multiple vendor addresses printed on the card. King teaches multiple advertisements printed on the card (col. 2 lines 50-52). Because King also suggests the use of said card by a hotel, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to advertise a host of hotel-related businesses on the card, such as shops in the hotel building and taxi companies, which reads on multiple participating vendor addresses. Further, because such cooperative advertising would promote all the participating businesses, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of King to those of Rodriguez et al.
7. Rodriguez et al. does not teach a promotion code printed on the card. Rubstein et al. teaches a *game code* (promotion code) printed on the card (para. [0055]). Because Rubstein et al. teaches that this provides security (the *control feature*), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Rubstein et al. to those of Rodriguez et al.
8. Rodriguez et al. also teaches claims 5, 10 and 12.
9. None of the references teach (claims 6, 8, 11 and 13) printing on the opposite side. Because it would be counterproductive to print everything on one side of the card, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to print on the opposite side of the card.

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**(11) Response to Argument**

35 USC 101 Rejection - Claims 4-8 were rejected because they describe printed matter that is not functionally related to a computing process. The claims do refer to web site, but the instant invention merely records the web site address. That is not a functional relationship with the web site.

Put another way, the subject card invention defined by claims 4-8 is not statutory subject matter because it merely records information, and does not produce a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). By contrast, the method invention defined by claims 9-13 is statutory because it teaches a functional relationship with the web site, thereby producing a "useful, concrete and tangible result."

Appellant argues (p. 4-5) that the instant invention is statutory because it is not among the three categories of subject matter for which the Supreme Court has said that one may not obtain patent protection. The Court never said that all other subject matter, such a printed matter, is necessarily patentable.

Appellant argues (p. 5) that In re Miller provides support. However, Miller dealt with a measuring device, for which the subject printed matter, the units of measure printed on the device, do provide function: The device would be useless without said units of measure printed thereon. Such is not the case with the instant invention. The subject web site(s) would continue to function and be useful with or without the instant invention.

35 USC 103 Rejection – Appellant argues (p. 7 first full para.) that the business card of Rodriguez et al. does not visually display business information because it encodes the business information in machine readable form. That is not correct. The machine-readable code supplements the ordinary visual presentation of the card. From para. [0006] of Rodriguez et al. (emphases added):

"... the textual information on a business card is supplemented with steganographically-encoded, multi-bit binary data. The latter does not significantly distract from the visual aesthetics of the card (as would a bar code or the like), yet can be used by an associated computer to initiate a link to an internet site corresponding to the business card giver."

Appellant argues (p. 7 bottom) that the Rodriguez et al. does not teach "vendor promotion discount indicia printed on the business card", and refers to reference para. [0019]. While the rejection (para. 5 above, second sentence from the end) does refer to reference para. [0019], it also notes "the Internet-linking binary data printed on the card reads on discount indicia printed on the card." The teaching of said binary data is in para. [0006].

Two additional points need be made. First, the printing of said binary data does read on printing on the business card, and since the reference teaches a web site offering "promotion offers" (para. [0019]), said binary data also reads on "vendor promotion discount indicia". Second, while the reference does not teach that either the web site addresses or any information about the promotion is printed in human-readable form on the business card, para. [0006] and [0019] make it clear that such information would appear to the extent that it ordinarily does on a business card.

Appellant argues (p. 8 bottom) that the teachings of King and Rodriguez et al. are "completely non-analogous to one another". Both references teach business cards. It is true that each reference provides other features, but the addition of features to a business card hardly makes it non-analogous to any other business card.

Appellant argues (p. 9 last para) that King does not teach or suggest multiple participating vendor web site addresses. That is true, as the rejection (para. 6) acknowledges. The motivation to combine comes from both references. King teaches multiple advertising messages on a business card device taught to be especially useful in hotels (col. 2 lines 50-52). One of ordinary skill in the advertising art would know that hotels have long advertised cooperatively, with airlines as well as with local businesses (barber shops, restaurants), for example. Hence the extension to *participating* vendors is obvious from King.

One of ordinary skill in the advertising art would also know that premier hotels have, since at least the time of the instant invention, been active in putting their guest rooms online. That suggests the combination of the King novelty business card with the online-expedient business card of Rodriguez et al.

Appellant argues (p. 10 bottom) that the teachings of Rubstein and Rodriguez et al. are “completely non-analogous to one another”. One may argue about “completely”, because the two references do deal with promotions, but it is true that the two references are in somewhat different fields of endeavor. However, it has been held that a prior art reference may be relied upon as a basis for rejection of the claimed invention if it is reasonably pertinent to the particular problem with which the appellant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the particular problem is promotions, and Rubstein provides a critical justification for adding a promotion code, and that justification is security. Rubstein’s principal application is limiting the number of times that an electronic greeting card can be used or changed (para. [0012]), but the reference also teaches its use for limiting access to promotions [0055].

In practice, the promotion code security feature taught by Rubstein et al. (para. [0062] and [0064] as well as [0055]) could advantageously be added to the steganographically-encoded, multi-bit binary data printed on the business card of Rodriguez et al. (para. [0006]).

Appellant argues (p. 11 end of top para.) that the instant invention does not require a security feature. Appellant is entitled to his opinion, but one of ordinary skill in the promotion art would not agree. Theft of promotion benefits is a serious problem as old as promotions themselves. One of ordinary skill in the art would add a promotion code as taught by Rubstein to the teachings of Rodriguez et al. in order to limit access to the promotions taught by Rodriguez et al.

Appellant argues (p. 11 bottom para.) that there is “absolutely no basis” in the rejection argument (para. 9 above) that it is counterproductive to print on only one side of the card. Yet that is precisely appellant’s argument. Appellant claims a business card with multiple web site addresses. Unless appellant is contemplating a “business card” whose dimensions measure in feet, common sense would suggest that every surface would best be used.

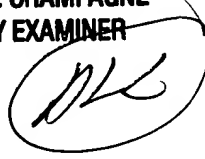
For the above reasons, it is believed that the rejections should be sustained.

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**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**



Respectfully submitted,

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

2 September 2004

Conferees

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